

REMARKS

In the Office Action dated August 1, 2005, the Examiner stated a certified copy of the priority document, on which Applicants base their claim for convention priority under 35 U.S.C. §119, had not been received by the Patent and Trademark Office. Accordingly, foreign priority was not granted.

The application transmittal sheet used for the original filing of the present application is in the Patent and Trademark Office electronic file, and item 12 thereof indicates that a certified copy of German Application 10029589.4, filed June 15, 2000, was among the documents accompanying the original application that was filed in the Patent and Trademark Office. Attached hereto is a copy of the stamped return postcard indicating receipt of the priority document, among the other original application papers.

The undersigned counsel for the Applicants has reviewed the publicly available electronic file for this application, and agrees that a scanned copy of the priority document is not present in the electronic file. Nevertheless, in view of the aforementioned evidence that the priority document was, in fact, not only mailed to the Patent and Trademark Office, but also received at the Patent and Trademark Office, the Examiner is requested to take the necessary steps to inspect the physical file, rather than relying on the electronic file. It is likely that the priority document was overlooked when the physical file was scanned, and therefore the priority document does not appear in the electronic file, despite the aforementioned evidence that it has been submitted to and received by the Patent and Trademark Office.

Turning now to the prior art rejections, claims 1 and 61-12 were rejected under 35 U.S.C. §102(e) as being unpatentable by Rozen et al. (Since the Rozen et

al. reference issued on June 6, 2000, even if Applicants are entitled to their convention priority date of June 15, 2000, the Rozen et al. reference would still be available as prior art. It is therefore not understood why the rejection based on Rozen et al. was made under 35 U.S.C. §102(e), rather than 35 U.S.C. §102(b).)

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rozen et al., further in view of Experton. Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rozen et al. and Experton, further in view of Nelson.

By the present Amendment, the subject matter of claim 5 (which, in turn, includes the subject matter of claims 4 and 2) has been embodied in independent claim 1, and accordingly claims 2, 4, and 5 have been cancelled. The dependency of claim 3 has been changed in view of the cancellation of claim 2.

Therefore, the only relevant rejection is the rejection of original claim 5, which is respectively traversed for the following reasons.

In rejecting the subject matter of claim 5, the Examiner relied on three references. The Examiner acknowledged that the Rozen et al. reference fails to expressly teach a mobile or remote access communication device, because the Rozen et al. reference is primarily directed to general communication devices such as telephones, telefax machines, and computers with internet connections. The Examiner relied on the Experton reference as disclosing phone lines and other types of connections such as wireless lengths, wherein extra speed is needed for making a communication connection. The Examiner stated it would have been obvious to a person of ordinary skill in the art to combine the wireless link connection disclosed in the Experton reference within the communication device taught by Rozen et al.,

based on the motivation to quickly access a large amount of data using a readily and widely available communications link.

The Examiner also acknowledged that the combination of Rozen et al. and Experton fails to expressly teach an authenticating or authorization access code in an electronically (computer) readable form, nor does that combination teach such a code being stored in an electronic chip. The Examiner relied on the Nelson reference as disclosing a computer readable microchip embedded in a tangible object, and stated it would have been obvious to a person of ordinary skill in the art to modify the Rozen et al./ Experton combination in accordance with the teachings of Nelson, based on the motivation to utilize technology that is more efficient and reliable.

Although the Examiner has identified reasons that the Examiner considers to constitute motivation for a person of ordinary skill in the art to modify the references in the manner proposed by the Examiner, Applicants respectfully submit that the alleged reasons for motivation are so general and broad as to be incapable of providing the necessary specific guidance or instruction that the case law requires for substantiating a rejection under 35 U.S.C. §103(a). Applicants respectfully submit that every designer of communications systems has the motivation to “quickly access a potentially large amount of data using a readily and widely available communications link” (the Examiner’s alleged motivation for modifying Rozen et al. in view of Experton), as well as the motivation to “utilize technology that is more efficient and reliable than standard authentication and authorization techniques” (the Examiner’s alleged motivation for modifying Rozen et al./ Experton in view of Nelson). These are such general and non-specific goals, and there are thousands of

ways of designing equipment to satisfy either or both of those goals, such that they provide no guidance whatsoever to a person of ordinary skill in the relevant art with regard to the subject matter of amended claim 1 of the present application.

The decisions of the United States Court of Appeals for the Federal Circuit make clear that something more than such non-specific, general design goals are necessary in order to provide the requisite evidentiary substantiation to support a rejection under 35 U.S.C. §103(a).

The Federal Circuit stated in *In re Lee* 227 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002):

The factual inquiry whether to combine references must be thorough and searching. ...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

Similarly, quoting *C.R. Bard, Inc. the M3 Systems, Inc.* 157 F.3d 1340, 1352, 48 U.S.P.Q. 2d 1225, 1232 (Fed. Cir. 1998), the Federal Circuit in *Brown & Williamson Tobacco Court v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-1125, 56 U.S.P.Q. 2d 1456, 1459 (Fed. Cir. 2000) stated:

[A] showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'.

In *In re Dembiczak*, 175 F.3d 994,999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999) the Federal Circuit stated:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

Consistently, in *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q. 2d 1453, 1459 (Fed. Cir. 1998), the Federal Circuit stated:

[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill in the art that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In *Winner International Royalty Corp. v. Wang*, 200 F.3d 1340, 1348-1349, 53

U.S.P.Q. 2d 1580, 1586 (Fed. Cir. 2000), the Federal Circuit stated:

Although a reference need not expressly teach that the disclosure contained therein should be combined with another, ... the showing of combinability, in whatever form, must nevertheless be clear and particular. Lastly, in *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376, 62 U.S.P.Q. 2d 1917 (Fed. Cir. 2002), the Federal Circuit stated:

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor.

Applicants respectfully submit that the general goals cited by the Examiner as alleged motivations for modifying Rozen et al. in view of the teachings of Experton, and for modifying Rozen et al./ Experton in view of the teachings of Nelson do not rise to the level of detail as required by the above-cited decisions in order to substantiate the rejection of original claim 5 under 35 U.S.C. §103(a). The alleged suggestions of motivations to combine references in order to properly substantiate a rejection under 35 U.S.C. §103(a) must be much more specific and explicit and must be present in the references themselves. Applicants respectfully submit the rejection of claim 5 under 35 U.S.C. §103(a) in the August 1, 2005 Office Action does not satisfy this standard.

Applicants therefore submit that the subject matter of amended claim 1 would not have been obvious to a person of ordinary skill in the field of designing tele-

health information systems for use by multiple patients, based on the teachings of Rozen et al., Experton and Nelson, under the provisions of 35 U.S.C. §103(a).

Claims 3 and 6-12 add further structure to the novel and non-obvious combination of amended claim 1, and therefore would not have been obvious to such a person of ordinary skill in the relevant technology for the same reasons discussed above in connection with claim 1.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,



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